

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 8/7/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Digital Sight/Sound, Inc.

Serial No. 75/351,134

Ansel M. Schwartz, Esq. for applicant.

Richard Y. Kim, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Simms, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Digital Sight/Sound, Inc. has filed a trademark application¹ to register the mark DIGITAL SIGHT/SOUND for "pre-recorded digital audio and digital video recordings and multimedia movies and cartoons only downloadable via global computer networks."² Applicant has disclaimed DIGITAL apart from the mark as a whole.

¹ Serial No. 75/351,134, in International Class 9, filed September 3, 1997, based on an allegation of a bona fide intention to use the mark in commerce.

² The Examining Attorney issued a final requirement for an acceptable identification of goods. Applicant, in its brief on appeal, adopted an

The Trademark Examining Attorney has issued a final refusal of registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SIGHT & SOUND, previously registered for "retail store and distributorship services in the field of videocassettes, video games, and video game accessories,"³ that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See, In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the

identification of goods that is substantially and sufficiently the same as the identification of goods proposed by the Examining Attorney, *i.e.*, we find a description of the cartoon features to be unnecessary. Thus, we consider the identification of goods to have been effectively amended consistent with the Examining Attorney's requirement, which we find to be moot. We note that a telephone call to applicant's attorney could have efficiently resolved any doubts held by the Examining Attorney regarding applicant's amendment to its identification of goods. Thus, the only issue before us on this appeal is likelihood of confusion.

³ Registration No. 1,946,632 issued January 9, 1996, to Sound Disk-Tributors, Inc. dba Sight & Sound Distributors, in International Class 42.

analysis of likelihood of confusion in this case, two key considerations are the similarities or differences between the marks and the similarities or differences between the goods and services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering, first, the marks, both applicant's mark and the registered mark contain the words SIGHT and SOUND in the same order. Applicant's mark separates these two words with a slash ("/") and the registered mark separates the words with an ampersand("&"). However, the two phrases are substantially similar, especially when we consider that consumers are not likely to encounter the marks side-by-side. Further, the admittedly descriptive word DIGITAL in applicant's mark merely modifies the phrase SIGHT/SOUND, which predominates in applicant's mark. Thus, we find that the commercial impressions of the two marks are substantially similar. We hasten to add that the words SIGHT and SOUND are highly suggestive in connection with applicant's goods and, at least, suggestive in connection with the videocassettes and video games that are the subject of registrant's services. This suggestiveness diminishes the scope of protection accorded to the cited

registration. *See, In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910 (TTAB 1988).

We consider, next, applicant's goods and registrant's services. The Examining Attorney contends that "[t]he goods and services at issue in [this] case specifically deal with video recordings and the services related to their sale." The Examining Attorney contends that applicant has not established that "the goods sold by the registrant are not of the kind identified in the application." He contends, further, that applicant's and registrant's prospective customers are the same; and that the registrant's recitation of services encompasses the trade channels identified by applicant.

Applicant contends, on the other hand, that the goods and services involved are quite different because applicant's goods are in the form of digital signals that must be downloaded from the Internet to a computer; that "[t]he fact that the goods and services involved in this case fall under the general category of electronics does not automatically mean they are related"; and that the channels of trade are different.

We find the Examining Attorney's contentions to be speculative and unsupported by any evidence in the record, not even dictionary definitions. We remind the

Examining Attorney that it is his burden to establish a likelihood of confusion, not the applicant's burden to establish that none exists, and the Examining Attorney has not met that burden. For example, we have no basis on this record to conclude that videocassettes and video games are the same as, or related to, digital audio and video recordings and multimedia movies and cartoons; that retail stores and distributors sell such products as applicant identifies; that retail stores and distributors of videocassettes and video games and accessories sell their products over the Internet or, if they do, that they do so in the same manner as applicant through a downloading process; or that there is any basis for concluding that consumers would expect the goods and services involved in this case to come from the same source.⁴

In conclusion, notwithstanding the similarity in the commercial impressions of applicant's mark, DIGITAL SIGHT/SOUND, and registrant's mark, SIGHT & SOUND, the marks are suggestive of the respective goods and services and the Examining Attorney has not established a relationship between the goods and services or their

⁴ We note that, contrary to the Examining Attorney's contention, "retail store services" recited in a registration do not encompass mail order catalog services, which are generally separately identified.

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respective channels of trade. Thus, we find that contemporaneous use of these marks on or in connection with the respective goods and services involved in this case is not likely to cause confusion as to the source or sponsorship of such goods and services.

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Decision: The refusal under Section 2(d) of the Act
is reversed.

R. L. Simms

C. E. Walters

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board